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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,044	03/01/2002	Daisuke Miyakoshi	112108	2270
25944	7590	04/21/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			REILLY, SEAN M	
			ART UNIT	PAPER NUMBER

2153

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/085,044	MIYAKOSHI ET AL.	
	Examiner	Art Unit	
	Sean Reilly	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133): Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/30/04, 1/11/05</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action is a first action on the merits of this application. Claims 1-22 are presented for further examination.

Priority

1. The effective filing date for the subject matter defined in the pending claims in this application is March 27, 2001.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 19-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Regarding claims 19-22, since the claimed computer program product is not necessarily tangibly embodied on a computer readable medium, it is merely a manipulation of abstract ideas.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 15-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to discuss “determining a range where said first communication device can use network resources” with any level of detail to enable one of ordinary skill in the art. The specification merely recites the claim language in the summary and fails to provide any further details as to how or why a range is determined and/or used.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 6, 10, 15-16, and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Regarding claim 5, the limitation “bringing into direct contact” in line 2, renders the claim indefinite. It is presumed direct contact implies that no intermediary device is present between the first and second communication units.
7. Regarding claim 6, the limitation “a shorter distance wireless communication” in line 2, renders the claim indefinite. It is unclear whether the limitation is attempting to 1) restrict the wireless protocol utilized or 2) restrict the distance the second connection can be made in relation to the first connection distance. The latter is presumed.
8. Regarding claim 10, the claim as written is indefinite. It is not clear why communication protocol parameters for wired communications would be passed when the first communication

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units only communicate wirelessly. It is presumed only wireless communication parameters are passed.

9. Regarding claims 15-16 and 19-22, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

10. Regarding claims 15-16, inter alia, the limitation "determines a range" renders the claim indefinite. It is not clear what the range actually consists of, e.g. a range of resources the client may access or some other range relating the wireless distance of the node. The former is presumed.

11. In further considering claims 19-22, inter alia, the limitation "said program letting said computer" renders the claims indefinite. It is presumed that the computer program causes the computer to execute such instructions as defined by the computer program.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorndahl (U.S. Patent Publication Number 2002/0065099) and Favichia et al. (U.S. Patent Number 6,125,122; hereinafter Favichia).

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13. Regarding claims 1, 10, and 17-22, Favichia discloses a method of setting communication parameters, said method comprising:

- a connection step in which a first communication device is connected to a second communication device (nodes), each of which devices has a first communication unit communication, said devices being connected in said connecting step via respective said first communication units (Col 2, lines 59-61);
- a guide information communication step in which said first communication device sends, via its first communication unit, guide information (operating communication protocol) which is received by said second communication device via its first communication unit, said guide information concerning communication forms usable by said first communication unit of said first communication device (Col 2, lines 61-64); and
- a communication parameter determination step in which said second communication device determines on the basis of said guide information, communication parameters for use when said first communication device and said second communication device communicate via their respective first communication units (Col 2, lines 64-67).

Favichia does not explicitly recite the first communication units are wireless.

Additionally, Favichia does not explicitly recite a second communication unit within each communication device, where the second communication units are used to establish communication parameters for communication between the two devices over the *first* communication devices.

In an analogous art, Bjorndahl discloses a method for setting communication parameters between two communication devices (abstract). The two communication devices each house two communication units within, a first RF (wireless) and a second IR (§ 17). In the Bjorndahl system, communication parameters (protocols) for communicating using the first communication units (RF) are established over the second communication units (IR link) (§ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the connection establishment teachings of Bjorndahl (described above) within the Favichia system since connection establishment over a second network link within close proximity is more secure, particularly in the wireless environment which is vulnerable to eavesdropping (Bjorndahl § 43).

In further considering claims 19-22 and the limitation “detect that this communication device becomes communicable with other communication devices”, refer to Bjorndahl § 36 (periodically emitting an IR signal).

Additionally applicant’s attention is drawn to § 39 and figure 4 of Bjorndahl’s disclosure, where numerous electronic devices aside from cordless phones are able to establish connections in a similar manner.

14. Regarding claim 2, the combined system of Favichia and Bjorndahl teaches following completion of said communication parameter determination step, a communication parameter setting step is carried out in which said second communication device sets communication parameters determined in said communication parameter determination step, said communication

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parameters being used when said second communication device communicates with said first communication device via its first communication unit (Favichia Col 2, line 67 – Col 3, line 4).

15. Regarding claim 3, the combined system of Favichia and Bjorndahl teaches following completion of said communication parameter determination step, a communication parameter communication step is carried out in which said second communication device sends, via its second communication unit, communication parameters determined in said communication parameter determination step, which communication parameters are received by said first communication device via its second communication unit; and a communication parameter setting step is carried out in which said first communication device sets said communication parameters, said communication parameters being used when said first communication device communicates with said second communication device via its first communication unit (Favichia Col 2, line 67 – Col 3, line 4).

16. Regarding claim 4, the combined system of Favichia and Bjorndahl teaches following completion of said communication parameter determination step, a communication parameter communication step is carried out in which said second communication device sends via its second communication unit, communication parameters determined in said communication parameter determination step, which communication parameters are received by said first communication device via its second communication unit; and a communication parameter setting step is carried out in which said first communication device and said second communication device set said communication parameters, said communication parameters being used when said first communication device and said second communication device

communicate via their respective first communication units (Favichia Col 2, line 67 – Col 3, line 4).

17. Regarding claim 5, the combined system of Favichia and Bjorndahl teaches the connection in said connection step is established by bringing into direct contact said second communication unit of said first communication device with said second communication unit of said second communication device (IR line of sight connection, Bjorndahl ¶ 43).

18. Regarding claim 6, the combined system of Favichia and Bjorndahl teaches the connection in said connection step is established by a shorter distance wireless communication than the wireless communication between said first communication device and said second communication device via respective said first communication units (IR, Bjorndahl ¶ 43).

19. Regarding claim 7, the combined system of Favichia and Bjorndahl teaches said first communication device and said second communication device are communication terminals (e.g. codeless phone headset or codeless phone base station, Bjorndahl ¶ 34).

20. Regarding claim 8, the combined system of Favichia and Bjorndahl teaches either said first communication device or said second communication device is an access point for relaying communications when two or more other communication devices execute wireless communications (e.g. cordless phone base station, Bjorndahl ¶ 34).

21. Regarding claim 9, the combined system of Favichia and Bjorndahl teaches said communication parameter determination step, a communication protocol selection step is carried out in which said second communication device selects one or more communication protocols, said communication protocols being used when said second communication device

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communicates with said first communication device via its first communication unit (Favichia Col 2, line 67 – Col 3, line 4).

22. Regarding claim 11, the combined system of Favichia and Bjorndahl teaches a cryptograph key information communication step is carried out in which said first communication device sends, via its second communication unit, cryptograph key information, which cryptograph key information is received by said second communication device via its second communication unit, said cryptograph key information being used for encrypting and/or encoding information which said second communication device sends and/or receives via its first communication unit, and wherein said second communication device encrypts and/or encodes information which said second communication device sends and/or receives via its first communication unit, using said cryptograph key information (Bjorndahl ¶ 35).

23. Regarding claim 12, the combined system of Favichia and Bjorndahl teaches a cryptograph key information communication step is carried out in which said second communication device sends, via its second communication unit, cryptograph key information, which cryptograph key information is received by said first communication device via its second communication unit, said cryptograph key information being used for encrypting and/or encoding information which said first communication device sends and/or receives via its first communication unit, and wherein said first communication device encrypts and/or encodes information which said first communication device sends and/or receives via its first communication unit, using said cryptograph key information (Bjorndahl ¶ 36).

24. Regarding claim 13 and 14, the combined system of Favichia and Bjorndahl teaches an identifier communication step is carried out in which said first communication device sends, via

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its second communication unit, an identifier (encryption keys), which identifier is received by said second communication device via its second communication unit, said identifier being used for identifying said first communication device (Bjorndahl ¶ 35 and ¶ 36), and wherein said second communication device approves or rejects communications which said first communication device executes with said second communication device, using said identifier (authorized user access, Bjorndahl ¶ 43).

25. Regarding claims 15 and 16, as discussed above the combined system of Favichia and Bjorndahl teaches an identifier communication step is carried out in which said first communication device sends, via its second communication unit, an identifier (encryption keys), which identifier is received by said second communication device via its second communication unit, said identifier being used for identifying said first communication device (Bjorndahl ¶s 35, 36, and 43), and wherein said second communication device determines a range where said first communication device can use network resources in a wireless communication which said first communication device executes via its first communication unit, using said identifier (authorized user access, Bjorndahl ¶ 43).

Conclusion

26. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

27. This office action is made **NON-FINAL**.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


4/7/2005


Dung C. Dinh
Primary Examiner